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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Knut E. Rasmussen

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Varian Inc  
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EXAMINER

YU, MELANIE J

ART UNIT

PAPER NUMBER

1641

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/857,132	<b>Applicant(s)</b> RASMUSSEN ET AL.	
	<b>Examiner</b> MELANIE YU	<b>Art Unit</b> 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/18/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's arguments filed 18 February 2009 have been considered and entered. Previous rejections of the claims have been withdrawn.

### ***Status of the Claims***

2. Claims 42-47 are currently pending and are examined on the merits. Claims 1-41 and 48-61 have been canceled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 42-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Coughlin et al. (US 5,277,821).

Coughlin et al. teach a method comprising the steps of:

providing a first container having a sample solution comprising a dissolved analyte (feed sample, col. 10, lines 65-67; feed sample may be in first container, col. 11, lines 47-51);

providing a second container with a membrane wall having fiber pores permeable by the analyte dissolved in the sample solution (col. 10, line 67-col. 11, line 4; solvent may be in the lumen of the fiber, lumen is the second container and has porous fiber defining the outer edge of the lumen; col. 11, lines 47-51);

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filling the second container with an acceptor solution (organic solvent in second container, col. 11, lines 47-51);

lowering the second container into the first container with the sample solution therein (fiber is mounted on spindle and placed in first container, col. 10, line 67-col. 11, line 4; first container may contain feed sample, col. 11, lines 47-51);

stirring the sample solution until equilibrium is established between analyte in the sample solution and analyte in the acceptor solution by passing of analyte through the membrane wall (analyte transfers from the feed sample into the solvent liquid in the lumen of the fiber col. 11, lines 43-47); and

removing analyte enriched acceptor solution from the second container (stripping solution is placed in the lumen to remove the liquid containing the analyte, therefore analyte is removed, col. 11, lines 25-32).

Regarding claim 43, Coughlin et al. teach the method further comprising the step of impregnating the fiber pores with a liquid before lowering the second container into the first container (pores of fiber are filled with a solvent that fills and wets the pores before the feed sample is placed therein, col. 10, line 67-col. 11, lines 8).

With respect to claim 44, Coughlin et al. teach the step of lowering a second container into the first container comprising lowering a tubular microporous fiber into the first container (microporous fiber contains a lumen and is therefore tubular (col. 9, lines 47-57)).

Regarding claims 45 and 46, Coughlin et al. teach the step of lowering a tubular fiber comprising lower a closed end fiber into the first container (end of fiber is made

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non porous and is therefore closed, col. 9, lines 58-68) or lowering a center portion of a tubular fiber having two open ends into the first container (both ends of the fiber protrude above the upper surface of the fiber, therefore a center of the tubular fiber having two open ends of the portion inserted into the container, col. 10, lines 14-22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlin et al. (US 5,277,821) in view of Schoendorfer (US 5,438,984).

Coughlin et al. teach filling an acceptor solution into the second container, but fail to specifically teach the acceptor solution having a pH for ionizing the analyte to prevent ionized analyte from passing from the acceptor solution through the membrane wall and into the sample solution.

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Schoendorfer teaches a porous layer having a buffer with a pH that ionizes analyte (col. 24, line 63-col. 25, line 6), in order to retain the analyte in the porous layer.

Therefore it would have been obvious to one having ordinary skill in the art to adjust the pH of the acceptor solution of Coughlin et al., to ionize the analyte to prevent ionized analyte out of the porous material as taught by Schoendorfer, in order to provide most effective removal of analyte from the feed solution and prevent back diffusion.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 42-47 have been fully considered and are persuasive, but are moot in view of the new ground(s) of rejection. The previous rejections of the claims have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Coughlin et al. teaching the method recited by claim 1.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE YU whose telephone number is (571)272-2933. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on (571) 272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Yu/  
Patent Examiner, Art Unit 1641